

## **REMARKS**

The Office Action dated September 19, 2005 (hereinafter "Office Action") has been carefully reviewed. Claims 21-35 are pending in this patent application. Reconsideration of this application is respectfully requested.

## **INFORMATION DISCLOSURE STATEMENT**

On page 2 of the Office Action, the Examiner stated that "[t]he information disclosure statement filed 4/8/04 fails to comply with 37 CFR 1.98(a)(2)" since the rule requires submission of "a legible copy of each cited foreign patent document" and "[t]he foreign patent documents were not found in the parent application as indicated by applicant ... ." Applicants do not agree that their information disclosure statement submission fails to comply.

A copy of Applicants' above-identified Information Disclosure Statement (hereinafter "IDS") is attached hereto as Exhibit I. The IDS was timely submitted in accordance with 37 CFR 1.97(b)(3). The IDS appropriately omitted submitting foreign references listed therein to the PTO in accordance with 37 CFR 1.98(d), (d)(1), and (d)(2). In support thereof, Applicants provide a copy of a Supplemental IDS submitted in the parent patent application that lists the six (6) foreign patent documents. (See Exhibit II.) Receipt of the Supplemental IDS and all listed associated documents by the PTO including the six (6) foreign patent documents is evidenced by the stamped post card, a copy of which is attached hereto. (See Exhibit III.) Also attached hereto is a copy of a Form PTO-1449 bearing the initials of the patent examiner who considered these six (6) foreign

patent documents during the Examination of the parent patent application, as well as a copy of a Form PTO-892 listing one of the six (6) foreign patent references. (See Exhibit IV.) Surely the patent examiner would not have initialed the Form PTO-1449 if he not did actually review the foreign patent documents.

Thus, Applicants' IDS dated April 5, 2004 does not fail to comply with 37 CFR 1.98. Nevertheless, for the Examiner's convenience, Applicants are submitting the six (6) foreign patent references listed on the IDS. In the event that the Examiner still believes Applicants' IDS to be somehow deficient, Applicants request that the various documents submitted with this response be treated as another IDS for consideration by the U.S. Patent and Trademark Office. The Commissioner is hereby authorized to charge any fees due for consideration of such IDS to Deposit Account No. 13-0014.

### **35 U.S.C. § 101 Rejection**

The Office Action rejected claims 21-35 under 35 U.S.C. § 101 alleging "the claimed subject matter is directed to non-statutory subject matter. In particular, it was stated on page 2 of the Office Action that "regarding at least claims 21 and 29, the humerus, acromion, and glenoid surface which are naturally occurring non-statutory subject matter is positively claimed."

However, Applicants' are unaware of, and the Office Action fails to identify, any legal authority that prohibits a naturally occurring element to be included as an element in a claim which otherwise contains non-naturally occurring element(s)." Note that the "humeral prosthesis" element that physically

interacts with the resected natural humerus, the natural acromion, and the glenoid surface clearly is configured by human intervention. Moreover, if all patent claims that recite a naturally occurring element is not patentable under 35 U.S.C. § 101, then any claim that recites “water” would be defective. Clearly, many U.S. patents having claims that include water as an element have been issued by the U.S. Patent and Trademark Office throughout the years.

Consequently, claim 21-35 are believed to comply with 35 U.S.C. § 101. In the event that the Examiner maintains this rejection after considering the remarks set forth herein, Applicants request that the Examiner cite legal authority that 35 U.S.C. § 101 prohibits a naturally occurring element to be included as an element in a patent claim which otherwise contains non-naturally occurring element(s).

### **35 U.S.C. § 102 Rejection**

Claims 21-35 were rejected under 35 U.S.C. § 102 as being anticipated by Stroot (U.S. Patent No. 3,979,778). Reconsideration of this rejection is respectfully requested.

#### Discussion Regarding Patentability of Claim 21

Claim 21 recites the following limitations:

wherein, during abduction of said resected natural humerus, (i) said acromion-bearing portion contacts and bears directly against said natural acromion, and (ii) said glenoid-bearing portion contacts and bears directly against said glenoid surface.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. No part of Stroot's prosthetic component 12 "contacts and bears directly against Stroot's natural acromion as required by Applicants' invention of claim 21.

Indeed, Stroot at column 2, lines 26-33 reads as follows:

The upper half of the glenoid is removed to the base of the coracoid and the glenoid is excavated except for the outer rim. The glenoid component 10 is then fastened between the spine of the acromion 16 and the coracoid process 18. The glenoid component is fixed to the bone with glue or cement as is well known to those skilled in the art.

With the glenoid component 10 mounted in this manner (see, e.g., Figs. 2-3 of Stroot), no part of the prosthetic component 12 (including the superior side of its head 20) contacts and bears against Stroot's natural acromion during abduction of the humerus. Rather, the head 20 of the prosthetic component 12 contacts and bears against the concave articular surface 14 of the glenoid component 10 during abduction of the humerus as shown in Stroot's Fig. 3. Stroot simply lacks

this claimed feature. Since Stroot does not disclose each and every element of Applicants' claim 21, Stroot does not anticipate claim 21.

#### Discussion Regarding Patentability of Claim 29

Claim 29, inter alia, recites the following limitations:

wherein, during abduction of said resected natural humerus, (i) said acromion-bearing portion contacts and bears directly against at least a part of said natural acromion, and (ii) said glenoid-bearing portion contacts and bears directly against at least a part of said glenoid surface,

The discussion relating to the patentability of claim 21 is relevant to the patentability of claim 29. Thus, claim 29 is allowable over the cited art.

#### Discussion Regarding Patentability of Claims 22-28 and 30-35

Each of claims 22-28 and 30-35 each depends directly or indirectly from either independent claim 21 or 29. As a result, each of claims 22-28 and 30-35 is allowable for, at least, the reasons hereinbefore discussed with regard to claims 21 and 29.

## **Conclusion**

In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,

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